

U.S. Patent Application No. 09/900,533
Amendment dated November 30, 2005
Reply to Office Action of October 20, 2005

REMARKS/ARGUMENTS

Reconsideration and continued examination of this application are respectfully requested.

The amendment to the claims is fully supported by the present application, including the claims as originally filed. Claim 33 has been amended to include the subject matter of claim 55. Accordingly, no questions of new matter should arise and entry of this amendment is respectfully requested.

At page 2 of the Office Action, the Examiner rejects claims 25-32, 34-40, 42-54, and 56-59 under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement.

The Examiner asserts that the present specification does not teach that the pH of the fluid compositions may be at a level of 9 to 14, when only an acid is used in the fluid. For the following reasons, this rejection is respectfully traversed.

The present specification, including the claims as originally filed, does clearly provide a written description of the pH range set forth in claims 25 and 34 and the claims dependent thereon. For instance, at page 18, lines 6-15 of the present application, the application teaches an alkali metal formate, such as cesium formate, in the form of a completion fluid. This paragraph does not place any limitations with respect to the other ingredients that may be present with the alkali metal formate in the completion fluid. This paragraph states that the chelating agent can be present; meaning the chelating agent is optional. Further, the paragraph states that the pH of the composition, which refers to the completion fluid in this paragraph, can be "any pH." Further, the paragraph continues by stating that the pH of the completion fluid can be, in preferred embodiments, from about 9 to about 14. There is no requirement in this paragraph that an acid must be present and, clearly, this paragraph refers to the completion fluids described in the present application. Furthermore, at page

U.S. Patent Application No. 09/900,533
Amendment dated November 30, 2005
Reply to Office Action of October 20, 2005

24, lines 9-12 of the present application, the present application teaches that "[f]or purposes of the present invention," the completion fluid can contain at least alkali metal formate and at least chelating agent or at least one acid or both. Spent completion fluids are also referred to in this paragraph and elsewhere. Clearly, the present application teaches that the "completion fluid" includes an embodiment with an alkali metal formate and an acid, and, as referenced above, in the paragraph at page 18, lines 6-15, the "completion fluid" can have the pH range set forth in the claims rejected by the Examiner. In addition, at the paragraph beginning at page 24, lines 13-21, there is a further teaching that the completion fluids of the present invention (without limit to any ingredients) can have a high pH. Thus, there are numerous teachings in the present application to clearly support the claims rejected by the Examiner. Certainly, these disclosures reasonably convey to one skilled in the art that the inventors had possession of the claimed invention as set forth in claims 25-32, 34-40, 42-54, and 56-59. For these reasons, this rejection should be withdrawn.

At page 3 of the Office Action, the Examiner provisionally rejects claims 1, 3, 5-18, 20, and 22-24 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of co-pending U.S. Patent Application Number 10/216,048. For the following reasons, this rejection is respectfully traversed.

Since this is a provisional rejection and since this will be the only rejection pending, it is proper to withdraw this provisional rejection in the present application so that the present claims can issue into a patent. As the M.P.E.P. instructs, this obviousness-type double patenting rejection, if proper, can then be raised in co-pending Application No. 10/216,048. However, the applicants note that the claims in co-pending Application No. 10/216,048 recite an alkali metal tungstate, which is not recited in the present claims. The claims in each application would not be obvious to each other.

U.S. Patent Application No. 09/900,533
Amendment dated November 30, 2005
Reply to Office Action of October 20, 2005

The provisional rejection does not appear to be proper for this reason as well. Accordingly, the Examiner is respectfully requested to withdraw this provisional rejection and to allow all claims at this time.

At the bottom of page 3 of the Office Action, the Examiner rejects claim 33 under 35 U.S.C. §102(e) as being anticipated by Kunin et al. (U.S. Patent No. 6,340,712 B1). The Examiner asserts that Kunin et al. shows a composition which comprises potassium formate, a surfactant, and an acid, such as citric acid. The Examiner asserts that claims 1 and 4 of Kunin et al. further support this view. The Examiner further asserts that the level of formate in Kunin et al. may be as high as 60% and the level of citric acid may be as high as 1%. For the following reasons, this rejection is respectfully traversed.

As stated above, claim 55, which is dependent on claim 33, was objected to by the Examiner, but is otherwise considered allowable subject matter. The subject matter of claim 55 has been incorporated into claim 33. Accordingly, for these reasons, this rejection should be withdrawn.

In view of the above comments, the applicants believe that all claims are in condition for allowance and that the provisional obviousness-type double patenting rejection can be removed at this time as stated above.

CONCLUSION

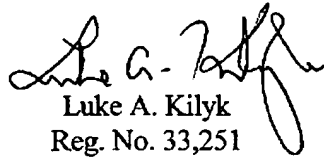
In view of the foregoing remarks, the applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

If there are any fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 03-0060. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not

U.S. Patent Application No. 09/900,533
Amendment dated November 30, 2005
Reply to Office Action of October 20, 2005

accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,


Luke A. Kilyk
Reg. No. 33,251

Atty. Docket No. 00087CIP (3600-295-01)
KILYK & BOWERSOX, P.L.L.C.
400 Holiday Court, Suite 102
Warrenton, VA 20186
Tel.: (540) 428-1701
Fax: (540) 428-1720